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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/994,846	11/28/2001	Mika Sugimoto	FJ-2001-030-US	8448

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EXAMINER	
ZHOU, TING	

ART UNIT	PAPER NUMBER
2173	

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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

**Office Action Summary**

Application No.

09/994,846

Applicant(s)

SUGIMOTO, MIKA

Examiner

Ting Zhou

Art Unit

2173

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 23 April 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-29 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) 17-20 and 27 is/are allowed.
- 6) ☒ Claim(s) 1-16, 21-26, 28 and 29 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                       | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

### **DETAILED ACTION**

1. The Request for Continued Examination (RCE) filed on 23 April 2007 under 37 CFR 1.53(d) based on parent Application No. 09/994,846 is acceptable and a RCE has been established. An action on the RCE follows.
2. The amendments filed on 14 March 2004, submitted with the filing of the RCE have been received and entered. Claims 1-29 as amended are pending in the application.
3. The examiner notes that claims 1-29 were previously indicated as allowable subject matter (35 U.S.C. 101 and 35 U.S.C. 112, 2<sup>nd</sup> paragraph rejections) in the office action dated 22 January 2007.

### ***Claim Rejections - 35 USC § 101***

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

4. Claims 1-16 and 21-26 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. Independent claims 1 and 8 claim a “program”, which is software per se, and software claimed by itself, without being executed or implemented on a computer medium, is non-statutory. However, the claims do not define a computer-readable medium or memory and is thus non-statutory for that reason (i.e., when functional descriptive material is recorded on some computer-readable medium it becomes structurally and functionally

interrelated to the medium and will be statutory in most cases since use of technology permits the function of the descriptive material to be realized). That is, the scope of the presently claimed program can range from paper on which a program is written, to a program simply contemplated and memorized by a person. The examiner respectfully notes that although claim 1 is amended to recite that the program is “executable by a digital processing apparatus”, the program is not necessarily executed by the apparatus. Claims 2-7, 9-16 and 21-26 are rejected for the same reasons as claims 1 and 8, respectively.

5. To expedite a complete examination of the instant application, the claims rejected under 35 U.S.C. 101 (nonstatutory) above are further rejected as set forth below in anticipation of the applicant amending these claims to place them within the four statutory categories of invention.

***Claim Rejections - 35 USC § 112***

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

6. Claims 1-7 and 21-26 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Claims 1-7 and 21-26 recite a homepage creation and update program, “tangibly embodied” as machine-readable instructions, etc. However, the applicant’s

specification does not provide a definition of what constitutes a tangible embodiment. Without a standard or definition of what embodiments are "tangible", i.e. a standard for determining when the program is tangibly embodied, it is unclear under what circumstances the program is considered tangibly embodied and under what circumstances the program is not considered tangibly embodied. Therefore, there is no positively recited basis for the limitation of "tangibly embodied".

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

7. Claims 8-16 and 28-29 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

- Claim 8 recites a "... program, which is started up on an image view screen...". This claim recites a product and process in the same claim. "A single claim which claims both an apparatus and the method steps of using the apparatus is indefinite under 35 U.S.C. 112, second paragraph" (see MPEP 2173.05(p), section II). The limitation, "which is started up on an image viewer screen" describes a method for using the claimed program, i.e. using the program by starting it on a screen that displays image files, and therefore, claims a product and process for using the product, which is indefinite. See *IPXL Holdings v. Amazon.com, Inc.*, 430 F.2d 1377, 1384, 77 USPQ2d 1140, 1145 (Fed. Cir. 2005); *Ex parte Lyell*, 17 USPQ2d 1548 (Bd. Pat. App. & Inter. 1990). Claims 9-16 depend upon claim 8 and are rejected for similar reasons.

- Claim 28 recites the limitation "said homepages" in line 3. There is insufficient antecedent basis for this limitation in the claim. Claim 29 depends upon claim 28 and is rejected for similar reasons.

***Allowable Subject Matter***

8. Claims 17-20 and 27 are allowed.

9. The following is a statement of reasons for the indication of allowable subject matter:

The present invention teaches a homepage creation and update tool that allows users to select desired displayed images to indicate a homepage creation or update using the selected images. Each of the independent claims 17 and 27 identifies the distinct feature of "when the user selects a plurality of desired images and indicates beginning of the homepage creation process, the selected images are sequentially presented individually in a predetermined order to said user to add comments before a homepage format of said image is generated that will automatically place said image into said selected layout format, if a new homepage is being created, or into an existing homepage layout, if an existing homepage is being updated". The closest prior art, Parker, in the book, The Complete Idiot's Guide to Microsoft FrontPage 2000 (hereinafter "Parker") teaches a homepage creation and update program (Microsoft FrontPage 2000) that causes a computer to execute the functions of displaying a plurality of stored images and allowing the user to select a desired image (displaying a plurality of files, such as clip art images, for users to import into a webpage) (pages 88-91), allowing the user to indicate a beginning of a homepage creation process (users can create a new website, or update a website by using the

FrontPage creator/editor to save and publish pages) (pages 15-16, 25 and 107), automatically performing the one of the creation and the update of a homepage using the desired image after the desired image is selected and the beginning of the homepage creation process is indicated by the user (after the user has added or edited a selected image, FrontPage will automatically create or update the page when the user selects the options to save the changes made to the website and upload and publish the newly added or edited images, pages etc.) (pages 26-27, 107 and 297-300); and arranging, when the user selects a plurality of desired images and indicates beginning of the homepage creation process, the selected plurality of images, automatically, according to image information stored in each image file by a camera (after the user has inserted or edited a selected image with corresponding image information stored in the image file, i.e. properties such as image width, height, direction, etc. in "Picture Properties", and selected the option to save and upload/publish the newly added or edited images to the web page, the web page is automatically created/updated with the images arranged in the user selected fashion, i.e. the size, height, placement, etc. of the images of the published website corresponds to the user edited "Picture Properties" information of the image; user can select images from a digital camera to be imported/uploaded into the webpage) (pages 26-27, 91-96, 102-107 and 297-300). However, the prior art fails to teach when the user selects a plurality of desired images and indicates beginning of the homepage creation process, the selected images are sequentially presented individually in a predetermined order to the user to allow the user to add comments before a homepage format of the image is generated that will automatically place the image into the selected layout format, if a new homepage is being created, or into an existing homepage layout, if an existing being updated; in other words, the prior art fails to teach allowing a user to merely select images, and

the tool will sequentially present these selected images so that the user can make comments for each image, and by only one additional command, the tool will then automatically generate the HTML code to place the image into the format of a new homepage or into the format of an existing homepage. Therefore, the prior art fails to anticipate or render the above limitations obvious.

10. Claims 1-16, 21-26, 28 and 29 would be allowable if rewritten or amended to overcome the rejection(s) under 35 U.S.C. 101 and 35 U.S.C. 112 rejections, set forth in this Office action.

11. The following is a statement of reasons for the indication of allowable subject matter:

The present invention teaches a homepage creation and update tool that allows users to select desired displayed images to indicate a homepage creation or update using the selected images. Each of the independent claims identifies the distinct feature of “when the user selects a plurality of desired images and indicates beginning of the homepage creation process, the selected images are sequentially presented individually in a predetermined order to said user to add comments before a homepage format of said image is generated that will automatically place said image into said selected layout format, if a new homepage is being created, or into an existing homepage layout, if an existing homepage is being updated”. The closest prior art, Parker, in the book, The Complete Idiot’s Guide to Microsoft FrontPage 2000 (hereinafter “Parker”) teaches a homepage creation and update program (Microsoft FrontPage 2000) that causes a computer to execute the functions of displaying a plurality of stored images and allowing the user to select a desired image (displaying a plurality of files, such as clip art images, for users to import into a



webpage) (pages 88-91), allowing the user to indicate a beginning of a homepage creation process (users can create a new website, or update a website by using the FrontPage creator/editor to save and publish pages) (pages 15-16, 25 and 107), automatically performing the one of the creation and the update of a homepage using the desired image after the desired image is selected and the beginning of the homepage creation process is indicated by the user (after the user has added or edited a selected image, FrontPage will automatically create or update the page when the user selects the options to save the changes made to the website and upload and publish the newly added or edited images, pages etc.) (pages 26-27, 107 and 297-300); and arranging, when the user selects a plurality of desired images and indicates beginning of the homepage creation process, the selected plurality of images, automatically, according to image information stored in each image file by a camera (after the user has inserted or edited a selected image with corresponding image information stored in the image file, i.e. properties such as image width, height, direction, etc. in "Picture Properties", and selected the option to save and upload/publish the newly added or edited images to the web page, the web page is automatically created/updated with the images arranged in the user selected fashion, i.e. the size, height, placement, etc. of the images of the published website corresponds to the user edited "Picture Properties" information of the image; user can select images from a digital camera to be imported/uploaded into the webpage) (pages 26-27, 91-96, 102-107 and 297-300). However, the prior art fails to teach when the user selects a plurality of desired images and indicates beginning of the homepage creation process, the selected images are sequentially presented individually in a predetermined order to the user to allow the user to add comments before a homepage format of the image is generated that will automatically place the image into the selected layout format,

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if a new homepage is being created, or into an existing homepage layout, if an existing being updated; in other words, the prior art fails to teach allowing a user to merely select images, and the tool will sequentially present these selected images so that the user can make comments for each image, and by only one additional command, the tool will then automatically generate the HTML code to place the image into the format of a new homepage or into the format of an existing homepage. Therefore, the prior art fails to anticipate or render the above limitations obvious.

### *Response to Arguments*

12. Applicant's arguments filed 14 March 2007 have been fully considered but they are not persuasive. The applicant stated that the claims have been amended to overcome the 35 U.S.C. 101 rejection, however, the examiner respectfully argues that the "program" recited in claims 1-16 and 21-26 is still software per se.

MPEP 2106.01 reads as follows:

Descriptive material can be characterized as either "functional descriptive material" or "nonfunctional descriptive material." In this context, "functional descriptive material" consists of data structures and computer programs which impart functionality when employed as a computer component. (The definition of "data structure" is "a physical or logical relationship among data elements, designed to support specific data manipulation functions." The New IEEE Standard Dictionary of Electrical and Electronics Terms 308 (5th ed. 1993).) "Nonfunctional descriptive material" includes but is not limited to music, literary works and a compilation or mere arrangement of data.

When functional descriptive material is recorded on some computer-readable medium it becomes structurally and functionally interrelated to the medium and will be statutory in most cases since use of technology permits the function of the descriptive material to be realized. Compare *In re Lowry*, 32 F.3d 1579, 1583-84, 32 USPQ2d 1031, 1035 (Fed. Cir. 1994) (claim to data structure stored on a computer readable medium that increases computer efficiency held statutory) and *Warmerdam*, 33 F.3d at 1360-61, 31 USPQ2d at 1759 (claim to computer having a specific data structure stored in memory held statutory product-by-process claim) with *Warmerdam*, 33 F.3d at 1361, 31 USPQ2d at 1760 (claim to a data structure per se held nonstatutory).

In contrast, a claimed *computer-readable medium* encoded with a computer program is a computer element which defines structural and functional interrelationships between the computer program and the rest of the computer which permit the computer program's functionality to be realized, and is thus statutory. See Lowry, 32 F.3d at 1583-84, 32 USPQ2d at 1035. However, claims 1-16 and 21-26 do not define a computer-readable medium or memory and is thus non-statutory for that reason (i.e., the program is not embodied on a **computer storage device** that allows the functionality of the program to be realized). Claims 1 recites that the program is capable of being executed by an apparatus, however, just because the program is *capable of* being executed by the apparatus, it does not mean that the program is *always* executed by the apparatus; in embodiments when the program is not actually being executed, it is just a program. The examiner further notes that as an *example*, claim language such as "A homepage creation update program embodied on a storage device, which causes a plurality of image files...." for claim 1 and "A homepage page creation and update program embodied on a storage device, wherein the homepage creation and update program causes a computer to execute the functions of" for claim 8 would be statutory because the program is executed on a computer-readable medium (such as the storage device described in the specification of the instant application), whereas the program as presently claimed lacks such a storage/memory device. The examiner respectfully maintains that given the broadest reasonable interpretation, claim 1 is simply reciting a program, which is software per se, and software that is not embodied on a computer-readable medium is non-statutory.

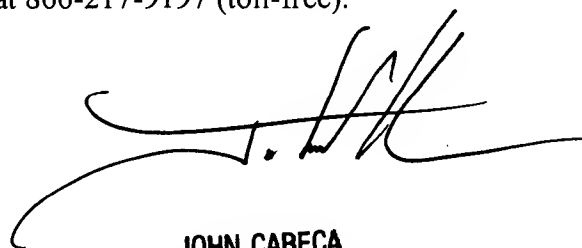
### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ting Zhou whose telephone number is (571) 272-4058. The examiner can normally be reached on Monday - Friday 7:00 am - 4:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Cabeca can be reached at (571) 272-4048. The fax phone number for the organization where this application or proceeding is assigned is (571) 273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

TZ

A handwritten signature in black ink, appearing to read 'J. Cabeca', with a long horizontal flourish extending to the left.

**JOHN CABECA  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 2100**